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IN THE
Supreme Court of the United States

OCTOBER TERM, A. D. 1942.

HARVEY S. COVER,

Petitioner,

v.

NATHAN SCHWARTZ, doing business as HYGEIA RESPIRATOR CO.,

Respondent.

**PETITION FOR WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE
SECOND CIRCUIT, AND BRIEF IN
SUPPORT THEREOF.**

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INDEX

	PAGE
Petition for writ of certiorari to the Circuit Court of Appeals for the Second Circuit	2
Statement	3
Statement of Jurisdiction	9
Questions presented	10
Reasons relied upon for allowance of the writ	11
Certificate	14
Brief in support of petition for certiorari	16
Jurisdiction	16
Statement of the case	16
Specification of error	17
Summary of argument	17
Argument	18
Conclusion	23

TABLE OF AUTHORITIES CITED

The Barbed Wire Patent, 145 U. S. 275, 1892	21
Chicago Foundry Co. v. Burnside Foundry Co., 56 U. S. P. Q. 283	19, 20, 21
Consolidated Store Service Co. v. Seigel-Cooper Co., 107 F. R. 716	6
Dececo Co. v. Gilchrist Co., 125 F. R. 293	6

Diamond Rubber Co. v. Consolidated Tire Co., 220 U. S. 428, 1911	21
Eibel Process Co. v. Minnesota, etc., 261 U. S. 45, 1923	22
Krementz v. Cottle Co., 148 U. S. 556, 1893	21
Lawther v. Hamilton, 124 U. S. 1	6
McClain v. Ortmyer, 141 U. S. 425	6
Minerals Separation Co. v. Hyde, 242 U. S. 261, 1916....	22
Parke-Davis v. H. K. Mulford Co., 189 F. 95, 115.....	8, 9
Ruby Picard v. United Aircraft Corp., 128 F. (2d) 632	8, 10, 18
U. S. Gypsum Co. v. Consolidated Expanded Metal Co., 130 F. (2d) 888, 892	21
Walker on Patents, 6 Ed., Sec. 73	6
Wallace v. Woolworth Co., 45 F. S. 466, 53 U. S. P. Q. 621	22
Webster Loom v. Higgins, 105 U. S. 580, 1881	22

STATUTES.

Revised Statutes, Section 4886, United States Code Annotated, Title 35, Section 31	11
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**PETITION FOR WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE
SECOND CIRCUIT.**

*To the Honorable Chief Justice of the United States and
Associated Justices of the Supreme Court of the United
States:*

Your petitioner, Harvey S. Cover, prays for a writ of certiorari to the Circuit Court of Appeals for the Second Circuit, to review that portion of the judgment of that Court entered January 11, 1943, holding Claims 1-8 and 10 of Patent No. 2,065,304 to Harvey S. Cover invalid (Opinion R. 391).

A transcript of the record in the case, including the proceedings in said Circuit Court of Appeals, is furnished herewith, in accordance with the rules of said Court.

STATEMENT.

1. Your petitioner seeks a reversal of that portion of the judgment of the Circuit Court of Appeals for the Second Circuit, affirming the judgment of the District Court for the Southern District of New York, which held Claims 1-8 and 10 of patent No. 2,065,304, dated Jan. 9, 1936 (R. 162), issued to Harvey S. Cover, relating to Respirators, invalid for want of invention. Infringement was conceded.

2. This suit was filed on June 7, 1937, being the usual suit for infringement of claims 1 to 8 and 10 of the patent, injunction, accounting, etc. There was a counterclaim filed, but this was dismissed and is not important here. This suit, was tried together with another suit filed by the plaintiff on two other patents. The other suit is not in any way involved in this proceeding.

After suit was filed, an interference was declared on the 16 day of July, 1937, relating to the subject-matter of the patent between the same parties to the suit. The trial of the case was enjoined until the completion of the interference. The interference proceeded through the Examiner of Interferences, the Board of Appeals and the United States Court of Customs and Patent Appeals, which decided in favor of the plaintiff Cover.

When the case came on for trial, in November 1941, the defendant waived the defense on non-invention and claimed that the defendant, Schwartz, was the first inventor of the subject-matter of the patent. Infringement was conceded

(R. 27-28). Although the question of want of invention was waived, the District Court held that the patent was invalid for want of invention over patent 2,019,928 (R. 274) to Punton, filed December 18, 1934, and issued November 5, 1935.

Both parties agreed that the subject-matter involved invention. Not one witness testified to the contrary. The defendant Schwartz, who had 33 years experience in respirators, not only stated by his counsel that the only issue would be priority, but testified that the subject-matter of the patent involved invention. He testified on cross examination:

"For argument, I concede, your Honor, that there is invention in placing this filter pad behind this particular flange, and I showed it on June 22nd in the Patent Office before Cover, and therefore I contend it is my invention. (R. 43.)

"I will again concede, in my opinion, that there is involved invention in placing extrusions in the plate of the filter holder." (R. 43.)

All the witnesses who testified on invention testified that the subject-matter involved invention. The only witnesses produced by the defendant were for the purpose of proving that Schwartz was the prior inventor.

The District Court failed to find in favor of Schwartz on this claim that Schwartz was the prior inventor. The Court, although not making a formal finding of the matter, held that Cover was the prior inventor (R. 155).

In view of the fact that the defense of non-invention was waived, the plaintiff produced in evidence the proceedings in the Court of Customs and Patent Appeals, awarding priority to Cover, and rested, without calling to the stand the inventor.

Despite the fact that the only issue was priority, and despite defendant's testimony that invention was involved in the patent, the Court held the patent invalid for want of invention, on the authority of *Cuno v. Automatic Service Corp.*, 314 U. S. 84, 91.

The defendant's only contention was that Schwartz was the prior inventor, and his counsel stated:

"Mr. Halle, what we are trying to demonstrate is that Cover was not the first inventor" (R. 37).

The patent in question relates to improvements in respiratory masks for miners, and other workers, the purpose of which is to protect the wearer against dust and poisonous gases and the occupational diseases which might otherwise result.

The proof showed that the most important features in a respirator are comfort and minimum breathing resistance. The breathing resistance, especially in a heavy respirator, reduces the wearer's physical efficiency and may cause him to work without a respirator, with consequent ill consequences to his health. Workmen do not like to wear respirators, and disregard them frequently when they are not under observation. The record showed further that it is essential that the respirators be made with a maximum of comfort, lightness in weight, efficiency and convenience.

The Punton device, in order to overcome breathing resistance, is primarily concerned with the use of a piece of filter paper 7, adapted to be vibrated to check off dust, etc. deposited by the elements.

Among other elements there were five elements including a purported cover which were essential to the Punton device, which we will not detail at this time.

This Punton device represented the best conception of a practical respirator known to Punton or to the Mine Safety

Appliance Co., which is the assignee of the Punton patent. The Mine Safety Appliance Co. is the largest manufacturer of respirators in this country. All these parts were essential to the Punton device, which was presumably the latest and the best that the skill of the art could supply.

Cover, however, by a brilliant conception produced a new and startlingly improved device so that a lesser number of parts performed all the functions of the greater number, and made an invention of a high order. He eliminated all the five aforesaid parts from the Punton device, which those skilled in the art considered essential, and showed that the perforated cover was as unnecessary as a perforated cover would be over eye-glasses to "help vision". He also showed that the extra parts involved disadvantages because they added weight and provided additional discomfort and blocked off 75 per cent of the breathing area of the filter, besides causing the respirators to be more expensive to make.

The United States Supreme Court has a number of times stated:

"A reconstruction of a machine so that a less number of parts will perform all the functions of the greater, may be invention of a high order * * * It is invention to omit from a prior process a step which those skilled in its performance consider essential but which the inventor proved to be useless."

Walker on Patents, 6 Ed., Sec. 73;

McClain v. Ortmyer, 141 U. S. 425;

Lawther v. Hamilton, 124 U. S. 1;

Consolidated Store Service Co. v. Seigel-Cooper Co., 107 F. R. 716;

Dececo Co. v. Gilchrist Co., 125 F. R. 293.

The record shows that everybody but the trial Judge considered the Cover improvement an invention, to-wit: the Examiner of Interferences, the three members of the

Board of Appeals and five Judges of the Court of Customs and Patent Appeals, in addition to the parties themselves and the expert witnesses. The defendant not only conceded the improvement but thought so highly of the invention he rushed a patent application into the Patent Office, claiming to be the prior inventor, and tried to get a patent on the same invention, and contested a long, bitter and expensive fight to the Court of Customs and Patent Appeals to try to obtain a patent on the invention.

The evidence showed that the experienced defendant, Schwartz had just introduced two new respirators on the market which he advertised as "new," "the easiest" and the "lightest" on the market. Despite this, as soon as Schwartz saw the Cover device on the market, he immediately and deliberately imitated that device. The defendant Schwartz immediately sought to have tests made of his device by the Standard Saftey Equipment Co. of Chicago, to see if he could obtain the approval of the United States Bureau of Mines, which he had never been able to obtain. The Standard Company (which was Schwartz' jobber) called attention to the obvious infringement on the Cover patent and urged that Schwartz give very serious consideration to the patent situation before investing any further money in the development of the respirator. Schwartz then notified the Standard Company that he was discontinuing the respirator. The Standard Company, which sells a larger variety of respirators than any other Company in the United States, wrote Schwartz as follows:

"It happens that at the present time we are selling a very considerable quantity of the new Dupor (the Cover device) simply because it is a good respirator. If you can produce something that is better, we can assure you we will be glad of the opportunity to sell it. * * * We felt you would not want to stick your neck

out for trouble and that a little warning in advance, based on our acquaintance with other respirators, might save you some money and a lot of grief, for patent suits are expensive whether you win or lose them. (I. R. 345.) In the face of all this warning and notice, Schwartz nevertheless went ahead copying the invention and obtained a Bureau of Mines Approval for the first time in his life. (I. R. 287, *et seq.* 730.)

The record shows that Schwartz had filed about 25 patent applications on respirators without being able to make the invention (R. 95).

The record shows that the prior art Punton patent which was held to invalidate the Cover patent, was considered in the Patent Office, and that the presumption of validity resulting from the allowance of the Cover patent was strengthened by the bitter interference contest waged against it by Schwartz to the Court of last resort, to-wit: the Court of Customs and Patent Appeals. The record also shows that 27,287 devices like that of the Cover patent were sold between October, 1936 and December, 1938, the date when the testimony regarding commercial success was taken.

The Court admitted that it was "not skilled in the art." (R. 38).

The Second Circuit Court of Appeals admits that very few men on the bench can qualify as scientific experts.

Parke-Davis v. H. K. Mulford Co., 189 F. 95, 115;

Picard v. United Aircraft Corporation, decided May 28, 1942, 128 F. (2d) 632.

more than the ordinary skill of the art * * * (basing its holding on the authority of *Cuno Engineering Corporation v. Automatic Service Corporation*, 314 U. S. 84, 91).

“How long we shall continue to blunder along without the aid of unpartisan and authoritative scientific assistants in the administration of justice, no one knows. * * *” (*Parke-Davis v. Mulford*.)

Judge Frank, in his concurring opinion in the *Picard* case refers to the “haphazard” scientific information of justice.

Despite all this, and despite the testimony of the defendant himself (an expert with 33 years experience) to the inventive advantages of the Cover device, and despite the defendant’s concession of inventiveness, the lower Court (which confessed itself unskilled in the art) held the patent invalid.

The *Cuno* decision had been handed down just before the trial, and the court at the beginning of the trial called the attention of the attorneys to that decision, and stated that the Judges of the District Court for the Southern District of New York had held a meeting to consider the implications of the *Cuno* case and had decided that they would hold nothing could be an invention which was not a basic invention, “such as the McCormick reaper or something like it.”

We submit that the Court narrowly interpreted the *Cuno* case to mean a literal “flash of genius” and thereby misconstrued the *Cuno* decision.

The Circuit Court of Appeals, also confessedly unskilled in the art, held the patent invalid despite the fact that the testimony was all to the contrary; that there was no testimony that the Cover device lacked invention, and that invention was not an issue. The Circuit Court of Appeals gave no reason for its holding of invalidity except to conclude that the Cover improvement involved “no

more than the ordinary skill of the art * * *” (basing its holding on the authority of *Cuno Engineering Corporation v. Automatic Service Corporation*, 314 U. S. 84, 91).

In view of the sole reliance upon the *Cuno* case in the matter of invention, and in view of the *Picard* case, 128 F. (2) 632, we submit that the Circuit Court of Appeals narrowly construed the *Cuno* case to require a literal "flash of genius" for an invention, and to mean that "Nothing is an invention which was the product of the slow but inevitable progress of an industry through trial and error," and of "the exercise of persistent and intelligent search for improvement." We submit that the Circuit Court of Appeals thereby misconstrued the *Cuno* case. *Picard v. United Aircraft* (C. C. A. 2), 128 F. (2d) 632.

Statement of Jurisdiction.

The jurisdiction of this Court is invoked under the provisions of Sec. 240 of the Judicial Code as amended by the Act of February 13, 1925 (28 U. S. C. Sec. 347). The date of the judgment to be reviewed is Jan. 11, 1943.

Questions Presented.

1. Shall the finding of a governmental agency, the Patent Office, that the Cover patent involved invention over the Punton patent be reversed, contrary to all the evidence, in the face of the fact that invention was not an issue and that all the testimony was to the effect that the Cover patent involved invention, including the testimony of the defendant who had engaged in a bitter interference and had contested it to the U. S. Court of Customs and Patent Appeals to obtain the patented invention, especially when the courts admit that they are not skilled in the art and when both parties have been experienced in the art for at least a third of a century *on the theory that the Cuno case requires a literal "flash of genius" and excludes all that is the product of the "exercise of persistent and intelligent search for improvement"?*

2. Is the Circuit Court of Appeals of the Second Cir-

cuit correct in holding that "nothing is an invention which is the product of the slow but inevitable progress * * * through trial and error and of the exercise of persistent and intelligent search for improvement," and in applying its announced interpretation of the *Cuno* case to hold claims 1-8 and 10 of Cover patent 2,065,304 invalid?

3. Did the elimination by Cover of elements considered indispensable by the prior art, which elimination produced a definitely superior and improved device, involve invention over the Punton patent and the prior art?

Reasons Relied Upon for Allowance of the Writ.

1. The Circuit Court of Appeals of the Second Circuit has literally construed the words "flash of genius" as used in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84, to mean a literal "flash of genius," and that "nothing is an invention which is the product of 'the slow but inevitable progress * * * through trial and error' and of 'the exercise of persistent and intelligent search for improvement.' "

Picard v. United Aircraft Corporation, 128 F. (2) 632.

In so doing it has:

(a) decided a federal question, in a way, probably in conflict with applicable decisions of this Court, including the *Cuno* case;

(b) interpreted the *Cuno* decision in conflict with the opinions of Courts of Appeals of other Circuits including the Sixth and Seventh.

(c) Decided a federal question in violation of Sec. 4886 of the Revised Statutes; U. S. Code, Annotated, Title 35, Sec. 31, to-wit:

"Any person who has invented or discovered

* * * a new and useful * * * machine, or any new and useful improvements thereof * * * may * * * obtain a patent therefor. * * *

(d) repealed by judicial legislation, Sec. 4886 of the Revised Statutes.

2. The Circuit Court of Appeals of the Second Circuit in applying this literal interpretation of the words "flash of genius" of the *Cuno decision*, to affirm the decision of the lower court which held claims 1 to 8 and 10 of Cover patent No. 2,065,304 invalid for want of invention over the Punton patent, although all the evidence on the subject of invention was to the effect that the Cover patent did involve invention over the Punton patent, so far sanctioned a departure from the accepted and usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

3. Your petitioner represents that he has no knowledge of any other infringement of patent No. 2,065,304 than by the defendant in this case, and no opportunity to bring another suit on the patent in another Circuit such as the Seventh or Sixth Judicial Circuits, to test the validity of the patent; or in any event to bring suit in said other Circuits so as to present a possible actual conflict on the same patent. Furthermore, if the holding of invalidity by the Circuit Court of Appeals is allowed to stand, a disclaimer will be necessary, which will make it impossible for plaintiff ever to present the question again, thus making it impossible to obtain a possible conflict of decisions in different circuits.

Congress, in Section 4886¹ of the "Revised Statutes"

¹ Section 4886 of "Revised Statutes" was enacted in 1870. During all that time Congress has not seen fit to change this statute. The action of the Circuit Court of Appeals of the Second Circuit amounts to judicial legislation.

did not limit the right to a patent on the method by which the invention was made, to-wit: either by a "flash of genius" or by "slow but inevitable progress" or "by persistent and intelligent search for improvement."

The Circuit Court of Appeals for the Second Circuit has, we submit, misconstrued the *Cuno* case in *Ruby Picard v. United Aircraft Corporation*, 128 F. (2) 632.

A definitive determination of this question is of the utmost importance to inventors, manufacturers, patent owners, and patent lawyers, among others. In the light of the interpretation given by the Second Circuit, and the contrasting interpretation given by the Sixth and Seventh Circuits to the words "flash of genius", the utmost confusion prevails as to what the Supreme Court means by "flash of genius" and as to what is an invention.

We realize that invention is not something tangible, or definite in itself—but, believe that it is possible for the Court to give some guide as to what it means by "flash of genius" and "invention."

In view of the disagreement in interpretation between learned, experienced Judges as to the meaning of the words "flash of genius" as used by the Supreme Court, it is manifest that the public interest would be served by a clarification of the meaning of "flash of genius". If the courts disagree, as we have indicated, on the meaning of the Supreme Court's language, manifestly it is impossible for patent owners to know what their rights are with any reasonable certainty.

We submit that the construction so given by the Circuit Court of Appeals of the Second Circuit amounts to

judicial legislation and that the foregoing manifestly constitute special and important reasons for this Court's exercising its judicial discretion to grant a review on Writ of Certiorari.

Wherefore, your petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Honorable Court, directed to the United States Circuit Court of Appeals for the Second Circuit, commanding that Court to certify and to send to this Court for its review and determination, on a day certain to be therein named, a full and complete transcript of the record and all proceedings on the case numbered and entitled on its docket, No. 74, Harry S. Cover, Plaintiff-Appellant *vs.* Nathan Schwartz, Defendant-Appellee, and that the said decree of the United States Circuit Court of Appeals for the Second Circuit be reversed by this Honorable Court, and that claims 1-8 and 10 of Cover patent 2065304 be held valid, infringement being conceded, and that your petitioner may have such other and further relief in the premises as to this Court may seem meet and just.

Most respectfully submitted,

HARVEY S. COVER,

By JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE,

Counsel for Petitioner.

Chicago, Illinois,
April 7, 1943

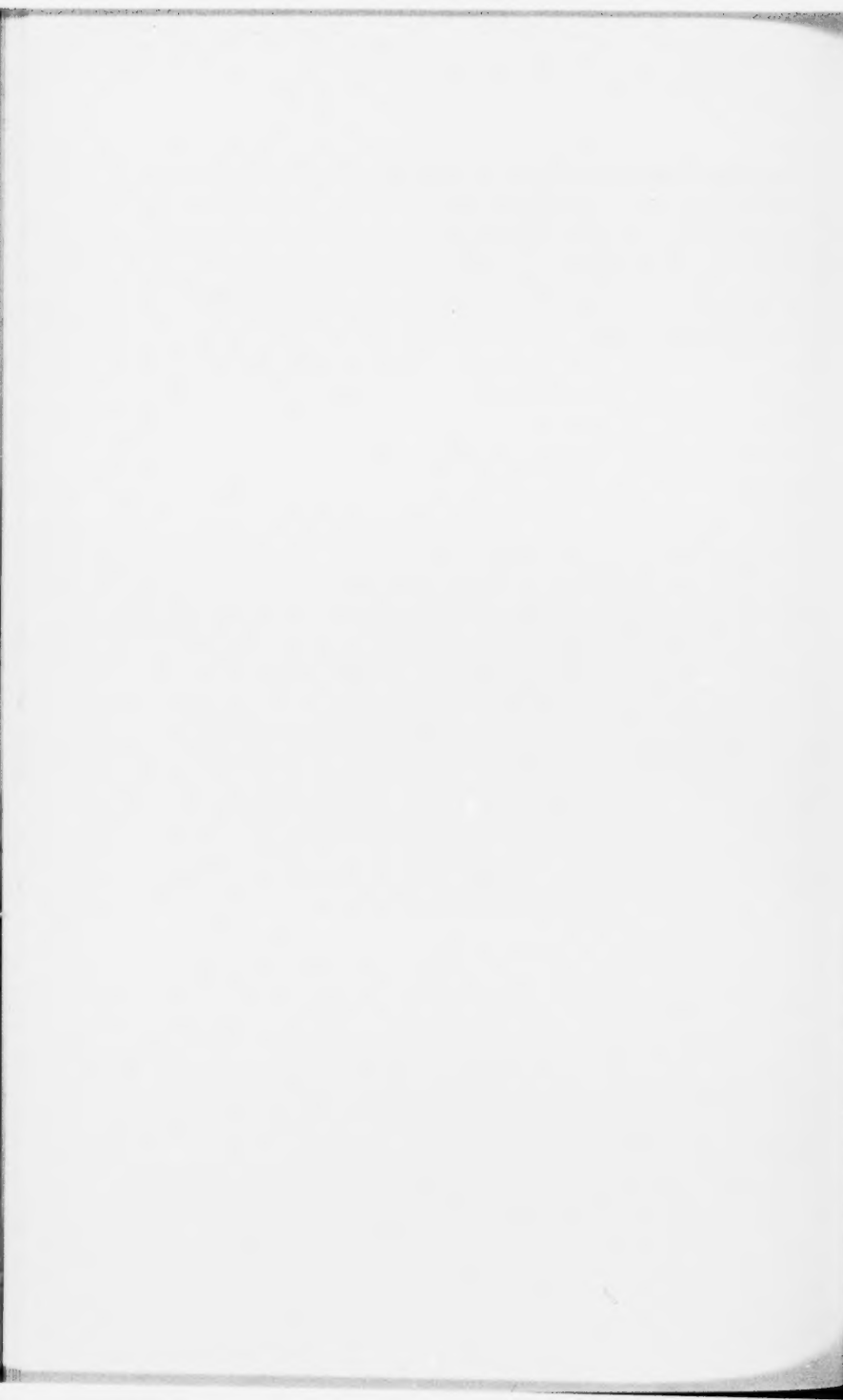
Certificate.

This petition is, in our judgment, well founded, and is not interposed for purpose of delay.

JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE,

Counsel for Petitioner.



IN THE

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HARVEY S. COVER,	v.	<i>Petitioner,</i>
NATHAN SCHWARTZ, doing business as HYGEIA RESPIRATOR CO.,		<i>Respondent.</i>

BRIEF IN SUPPORT OF PETITION FOR CERTIORARI.

The District Court's memorandum of opinion on this patent is printed at R. 365. The District Court made findings of fact (R. 367) and conclusions of law (R. 368).

The opinion of the Circuit Court of Appeals is given at R. 391. So far it is unreported.

Jurisdiction.

The statement of jurisdiction is set forth in the foregoing petition.

Statement of the Case.

The facts have been set forth in the foregoing petition.

Specification of Error.

1. The Circuit Court of Appeals for the Second Circuit erred in holding Claims 1 to 8, inclusive, and 10 of Cover patent No. 2,065,304, invalid for want of invention over the Punton Patent No. 2,019,928, in the face of the fact that invention was not in issue and all the evidence was to the contrary,

by applying its literal "flash of genius" definition, excluding "the exercise of persistent and intelligent search for improvement," etc., and ignoring the fact that the Supreme Court had used the words "flash of genius" merely as another way of describing what was "beyond the scope of the mechanic skilled in the art," and in the face of conflicting opinions in other circuits to the contrary.

Summary of Argument.

The opinion of the Second Circuit Court of Appeals is in conflict with the opinions of other Circuits, and the reasoning of the opinions in the other Circuits plainly shows that the Second Circuit Court of Appeals has misconstrued the *Cuno* case.

ARGUMENT.

The decisions of the Supreme Court of the United States for over a hundred years interpreted "invention" as meaning "something beyond the skill of the mechanic trained in the art." The Congress has impliedly expressed its satisfaction with such interpretation by failing to amend the statute.

"If Congress, speaking through its responsible members, had any intention of altering what theretofore had not been questioned, namely, that there was no statutory restraints upon assignment by authors of their renewal rights, it is almost certain that such purpose would have been manifested."

Fred Fisher Music Co. v. Witmark, Decided by this Court April 5, 1943.

The Supreme Court in using the term "flash of genius" was plainly not changing the previous requisite for invention, and the Circuit Court of Appeals of the Second Circuit in construing "flash of genius" to mean "spontaneous or instantaneous improvement" misinterpreted the meaning of "flash of genius."

The Circuit Court of Appeals for the Second Circuit has announced that it would regard nothing as an invention which was the product of

"the slow but inevitable progress of an industry merely through trial and error and confer a monopoly upon the exercise of persistent and intelligent search for improvement." *Picard v. United Aircraft Corp.*, 128 F. (2d) 632.

The concurring opinion of Judge Frank states that Judge Learned Hand applies the following negative test:

“* * * Nothing is an invention which is the product of ‘the slow but inevitable progress * * * through trial and error’ and of ‘the exercise of persistent and intelligent search for improvement.’”

The concurring opinion of Judge Frank, also, states:

“* * * And, in each patent suit, the patentee ought to be required to disclose precisely how he arrived at his new device, in order that the court, advised by its own experts, can tell whether it was merely the result of ‘trial and error’ and ‘the exercise of persistent and intelligent search for improvement,’ in which event, according to Judge Hand’s formula, the patent would not be valid. * * *”

This is entirely in conflict with the very late opinions in the sixth and seventh circuits.

The Circuit Court of Appeals of the Seventh Circuit, in the case of *Chicago Foundry Co. v. Burnside Foundry Co.*, decided January 20, 1943, 56 U. S. P. Q. 283, 132 F. (2d) 812, calls attention to the new phrases used to describe the test of invention and states:

“* * * The so-called changes in tests and in phrases describing them, have thus far failed to register strongly with us, as helpful in determining the question of invention.”

The Circuit Court of Appeals of the Seventh Circuit says that “genius” is a “misappellation” which cannot be “defined satisfactorily or in terms of easy and uniform application.” The Court said that such expressions as “flash of genius” are “glibly used, but they are difficult of helpful definition.”

The Court further states:

“* * * But what, may we ask, is gained in certainty or clarity by adopting as a test or a definition of pat-

entable invention or discovery, the 'a flash of genius' test? * * * is it understandable to say that there is patentable novelty if it results from a flash of genius, but not patentable invention if it is the result of long-continued experimentation? *We think not.*

"We are advised and believe that in the field of science nearly all advance is made in laboratories where many experiments are made and discoveries result from the trial and error method.

"We assume inventions of all kinds are desirable. Whether great or small, they are helpful."

The Circuit Court of Appeals of the Seventh Circuit stated that its digression might:

"* * * serve to reaffirm the recognized standards which throughout the past century have been applied by courts, with some degree of safety and satisfaction. * * *"

And, it emphasizes:

"* * * the soundness of the standards which have been applied when considering the validity of patents. * * *"

The Court said:

"* * * these old standards seem more real and are easier of application than for the court to ask itself, was this product born out of a flash of genius? * * *"

The Court stated the word "genius" to be:

"* * * a word to conjure with, elastic in meaning and appealing to the imagination. It may be said to be sufficiently elusive to avoid restriction or limitation of its meaning and yet suggestive of the activity of a super-brain, which only may bring forth inventions. * * *"

The Circuit Court of Appeals of the Seventh Circuit talked of "wrestling" with the word and discussed "flash of genius" as making the test of invention:

“* * * more baffling in its uncertainty and exclude the larger portion of those whose products have heretofore been understood as the work of an inventor.”

The Court assumed “in our efforts to define the work of a genius” that it manifests itself chiefly in capacities:

“* * * the capacity for taking pains, capacity for observing phenomena, capacity for long and studied experimentation with eyes that see, capacity for long continuous mental concentration with an objective clearly in view, etc.”

and found that such a definition of “genius” is:

“* * * at variance with that suggested by the expression ‘flash of genius.’ The test of flash of genius’ has been applied to curtail the field of patentable discovery and to *eliminate* from the protection of patents, all products (even though they came from the superior mind of genius) which were, nevertheless, the product of prolonged study and step by step advance.
* * *”

The sixth circuit is also in conflict with the second Circuit:

In *U. S. Gypsum Co. v. Consolidated Expanded Metal Co.*, C. C. A. 6, 130 Fed. (2nd) 888, 892, the court said:

“* * * This is imperative even though we are unable to go the whole way with Judge Learned Hand in his observation in the *Picard* case, *supra*, if correctly interpreted in the concurring opinion in that case as ‘a negative test’ by which it is determined that ‘nothing is an invention which is * * * progress * * * through trial and error.’ We remember that the patent law rewards both invention and discovery and that genius has well been defined as ‘an infinite capacity for taking pains.’ If the story of Edison’s long-continued search for an incandescent lamp filament be true, his genius responds to the definition.”

The District Court for the Eastern District of New York expressed disagreement with the Circuit Court of Appeals for the Second Circuit in *Wallace v. Woolworth Co.*, 45 F. S. 466, 53 U. S. P. Q. 621, said:

"Apparently the restricted monopoly of patent rights is not to 'reward the exercise of persistent and intelligent search for improvement.' Such is not deemed to 'reveal the flash of creative genius' specified as requisite in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 (51 U. S. P. Q. 272).

"And yet it must be recalled that genius has once been defined as the infinite capacity for taking pains. The approved approach to most unsolved problems is the studious and often plodding one, and no reliable substitute has been suggested, even though a solution thereby accomplished is not judicially deemed to attain to the status of patentable invention. Such is the minimizing lens supplied to a district judge for scrutinizing a patent submitted for adjudication."

The "flash of genius" test should be rejected for an additional reason, because it injects into the statute something not appearing therein, as stated by the Circuit Court of Appeals for the Seventh Circuit in *Chicago Foundry Co. v. Burnside Foundry Co.*, 56 U. S. P. Q. 283. The statute does not limit an improvement to the manner in which it is made in order to be an invention. The Federal decisions covering a century contain many to the effect that it is the effect of the accomplishment—novelty appearing, rather than the method of accomplishment, with which judicial inquiry is concerned. * * *

Diamond Rubber Co. v. Consolidated Tire Co.,
220 U. S. 428, 1911;

The Barbed Wire Patent, 145 U. S. 275, 1892.

Krementz v. Cottle Co., 148 U. S. 556, 1893;

Webster Loom v. Higgins, 105 U. S. 580, 1881;

Eibel Process Co. v. Minnesota, etc., 261 U. S. 45, 1923;

Minerals Separation Co. v. Hyde, 242 U. S. 261, 1916.

The questions before the Court are—What is the new product? What advance does it show over those in use or known to the art? Our interest is in the child, not in how or when it was born, or who are its parents. Section 31, Title 35, U. S. C. A.

Nowhere in the statute can be found any words which require, or permit us to inquire into the quality of mind or the activity of the mind of the inventor to determine the patentability of his products or processes. Congress was interested in protecting the product of the mind,—not in whether it came as a flash to the mind, or as a happy thought, or by long painstaking search and experimentation.

CONCLUSION.

We respectfully submit that the Circuit Court of Appeals for the Second Circuit, by its decision and its interpretation of the words “flash of genius” as used in *Cuno Corporation v. Automatic Device Corporation*, 314 U. S. 84 has completely misconstrued the rule laid down by this Court in that case, and has in effect repealed Section 4886 (U. S. C., Title 35, Section 31) of the Patent Laws, and has disregarded the explicit provisions of Section 4886 and is in conflict with the opinions in *Chicago Foundry Co. v. Burnside Foundry Co.*, 56 U. S. P. Q., 283 (C. C. A. 7); *U. S. Gypsum v. Consolidated Expanded Metal Co.*, (C. C. A. 6), 130 F. (2) 888, 892; *Wallace v. Woolworth*, (U. S. D. C., E. D. N. Y.), 45 F. S. 466.

To permit this decision to stand would mean that the Circuit Court of Appeals for the Second Circuit would find no invention in any improvement in effect, since the history of invention shows that probably no invention has ever been made by a "flash of genius".

The confusion resulting from the various interpretations given to "flash of genius" and the tremendous public interest involved are manifest. It is therefore respectfully submitted that this case is one calling for the exercise by this Court of its supervisory power by granting a writ of certiorari and thereafter reviewing and reversing the portion of the decision referred to and clarifying the decision in the *Cuno* case.

Most Respectfully submitted,

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April 7, 1943



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NO. 906

FILED
APR 27 1943

CHARLES ELMORE CROPLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

HARVEY S. COVER,
Petitioner,

v.

NATHAN SCHWARTZ, doing business
as Hygeia Respirator Co.,
Respondent.

OBJECTIONS TO WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT, AND ARGUMENTS IN SUPPORT THEREOF

NATHAN SCHWARTZ,
Respondent,
Pro se,
100 West 55th Street,
New York, N. Y.

Dated, New York, April 27, 1943.



IN THE
Supreme Court of the United States

OCTOBER TERM, 1942

HARVEY S. COVER,
Petitioner,

v.

NATHAN SCHWARTZ, doing business as
Hygeia Respirator Co.,
Respondent.

**OBJECTIONS TO WRIT OF CERTIORARI TO THE
CIRCUIT COURT OF APPEALS FOR THE SECOND
CIRCUIT, AND ARGUMENTS IN SUPPORT THEREOF**

*To the Honorable Chief Justice of the United States and
Associated Justices of the Supreme Court of the
United States:*

Your respondent, Nathan Schwartz, urges, that a *Writ of Certiorari* to the Circuit Court of Appeals of the Second Circuit, to review that portion of the judgment of that Court entered January 11, 1943, holding Claims 1-8 and 10 of patent No. 2,065,304 to Harvey S. Cover invalid, be denied.

Statement and Arguments

1. Respondent opposes a reversal of that portion of the judgment of the Circuit Court of Appeals for the Second Circuit, affirming the judgment of the District

Court of the Southern District of New York, which held Claims 1-8 and 10 of patent No. 2,065,304, dated January 9, 1936 (R. 162), issued to Harvey S. Cover, relating to Respirators, invalid for want of invention. Infringement was not conceded.

2. When the case came to trial in November, 1941, the defendant did not waive any defense, and did not waive the defense of non-invention. Infringement was not conceded. The defendant did state that if there was invention "I showed it on June 22nd in the Patent Office before Cover and therefore I contend that it is my invention."

3. Cover's attorney, Mr. Clarke, admitted that Schwartz was the first to file patent application on the subject matter:

"The Court: 'I still do not understand whether the Schwartz patent that is mentioned is prior art or not prior art with respect to any of the Cover patents. Perhaps the plaintiff can make some statement on that. Are any of the Schwartz patents earlier than all the Cover patents?'"

"Mr. Clarke: 'Some are and some are not.'" (R. 47 and 48)

Mr. Clarke is petitioner's attorney.

It is submitted that if the Schwartz patent on the subject matter with respect to the Cover patent is earlier than the Cover patent, that Schwartz is in fact the prior inventor.

4. The defendant's attorney stated:

"Mr. Halle, what we are trying to demonstrate is that Cover is not the first inventor." (R. 37)

The defendant's attorney also said:

“Mr. Halle: What I am trying to demonstrate is that Punton and Schwartz patents, which they do not admit are prior art, are prior art.” (R. 52)

It is therefore obvious that if the defense was demonstrating prior art, they did not concede that there was invention by Cover. The defendant has the right to believe that Punton showed invention or that Schwartz (the respondent herein) disclosed invention (see Punton patent, R. 274-282 and Schwartz patent 2,035,097, R. 292-294). It is on these two patents that the Cover patent 2,065,304 was held invalid. Respondent submits that petitioner herein is unduly ramming a proposition that defendant admits invention, that defendant admits infringement. The defendant stands on his rights and admits nothing that may be of any benefit to the plaintiff (petitioner). If the defendant at any time says that there is or was invention of certain subject matter, such as a flange securing a filter pad or a protrusion spacing a filter pad, that had distinctly been explained to be the invention of the defendant (respondent).

The Circuit Court's opinion makes this point clearer than the defendant (respondent) possibly could and they say:

“But the idea of a removable filter pad held in place by the flange had already been disclosed in an advertisement of appellee in October, 1935 and appellee has already suggested the corrugation of the base plate (Patent No. 2,035,097, issued March 24, 1936).¹ True the base plate there was of rubber, rather than of metal, as here, but this distinction is of no significance.” (R. 392—margin)

1. The said patent application was filed June 22, 1935.

5. Petitioner states that "the Court admitted that it was 'not skilled in the art.' " (R. 38). That was on R. 38, but during the trial the judge became quite familiar with the art. (See R. 135.)

The Court: "That was just a matter of convenience. How do you get any invention out of it?" Petitioner's expert answers: "Well, I do not know as to that." Please note that the Court from here on knows the subject matter as well as the petitioner's expert. (See R. 148.) The Court says: "These two exhibits Dr. Schwartz had in his hands a couple of hours, as I remember it. It is a very simple structure." Therefore at this point the Court realizes that the subject matter is simple.

On page R. 51 the Court says: "This is not such an awfully complicated apparatus but that anybody can see it if he wants to get at the facts." Therefore it did not take the Court much time to familiarize himself with the art to be able to say that the apparatus is simple.

6. On page 8 of Petition, the petitioner states: "The Circuit Court of Appeals, also confessedly unskilled in the art, held the patent invalid". Respondent denies that the Circuit Court of Appeals was confessedly unskilled in the art. As a matter of fact, Judge Learned Hand stated at the hearing that the Court was familiar with the subject matter of respirators, such cases having been heard before. When Judge Frank in his concurring opinion in the *Pickard* case¹ refers to the "haphazard" scientific information of justice, he refers to complicated scientific chemical, mechanical, or electrical problems. However, this apparatus was simple. That was soon discovered and so stated by the trial court, and also a similar statement was soon made by Judge Learned Hand. Respondent noticed

1. *Picard v. United Aircraft Corp.*, 128 F. (2nd) 632.

that the three judges of the Circuit Court of Appeals as well as the trial judge very quickly adapted and oriented their mentality to the device. The questions put to both plaintiff and defendant were pertinent.

7. Petitioner argues, page 8 of Petition, that the Circuit Court of Appeals held the patent invalid on no more ground than that the alleged improvement involved "no more than the ordinary skill of the art * * *." As a matter of fact while the trial court and also the Circuit Court of Appeals are firm without any reservations whatever that the improvement over Punton is merely mechanical. Yet the Circuit Court of Appeals states in the margin (R. 392) that "the idea of a removable filter pad held in place by flanges had already been disclosed in an advertisement of appellee in October, 1935. And appellee had already suggested the corrugation of the base plate (patent No. 2,035,097, issued March 24, 1936). True the base plate there was of corrugated rubber, rather than of metal, as here, but this distinction is of no significance." Therefore, while the Punton patent No. 2,019,918 was prior art sufficient to cause the trial court and the Appeal Court to concurrently decide that any alleged improvement claimed is only mechanical skill such as is expected of those skilled in the art, the Appeals Court placed further stress by stating that appellee (respondent herein) has in fact disclosed the mechanical improvement claimed.

It is apparent that even though due to some technical reasons appellee (respondent) was unable to obtain priority before the Court of Customs and Patent Appeals, yet, the disclosures of the respondent are prior, and the plaintiff (petitioner) so admitted (R. 47 and 48).

8. On page 9 of Petition, petitioner says: "In view of the sole reliance upon the *Cuno* case in the matter of

invention, and in view of the *Picard* case, 128 F. (2) 632, we submit that the Circuit Court of Appeals narrowly construed the *Cuno* case to require a literal 'flash of genius' for an invention, * * *." It is submitted that the Circuit Court of Appeals having cited the Punton patent 2,019,918, *supra*, and also cited the Schwartz patent No. 2,035,097, *supra*, did not literally construe "Flash of genius". But had in mind the admonition in the *Cuno* case that more must be done to be entitled to a patent than merely to combine the teaching of two or more inventions or devices. Because they plainly point out that Punton (*supra*) taught the article disclosed by cover and what Punton did not teach Schwartz did teach.

9. On page 12 of Petition, plaintiff states that "A definitive determination of this question is of utmost importance * * *". The Supreme Court has already clarified its position regarding combination or aggregation of claims in patents, in the *William Manufacturing Co. v. United Shoe Machinery Co.*, 53 U. S. P. Q. 478, May 25, 1942. (Respondent cannot offhand remember the full name and reference, and has no library reference at present.) It is submitted that other cases beside the *Cuno* case can be cited as authority.

10. Concurrent findings of the Trial Court and of the Circuit Court of Appeals is not disturbed by the Supreme Court unless there is definite proof that a clear error has been committed. In the instant petition a contortion citation is used to allege that the construction of the decision in the *Picard* case by the Second Circuit Court of Appeals as applying to the instant case. It's a far-fetched theory and therefore cannot be cited as clear error. It is inference and has no direct bearing and therefore may be called foreign or hearsay.

11. Only one Circuit has ruled on the question here at issue and therefore according to the rules of the Supreme Court, no writ of certiorari is justified. It is denied that similar articles are not manufactured. See Circulars of the Pulmosan Corp., 276 Johnson St., Brooklyn, N. Y.; Wilson Prod. Inc., Reading, Pa.

12. Regarding disagreements in interpretations between learned experienced judges as to the meaning of the words "flash of genius", it is submitted that that expression is not pertinent in the instant case. Neither the trial court nor the Appeals Court made use of expression in their opinions or findings of fact.

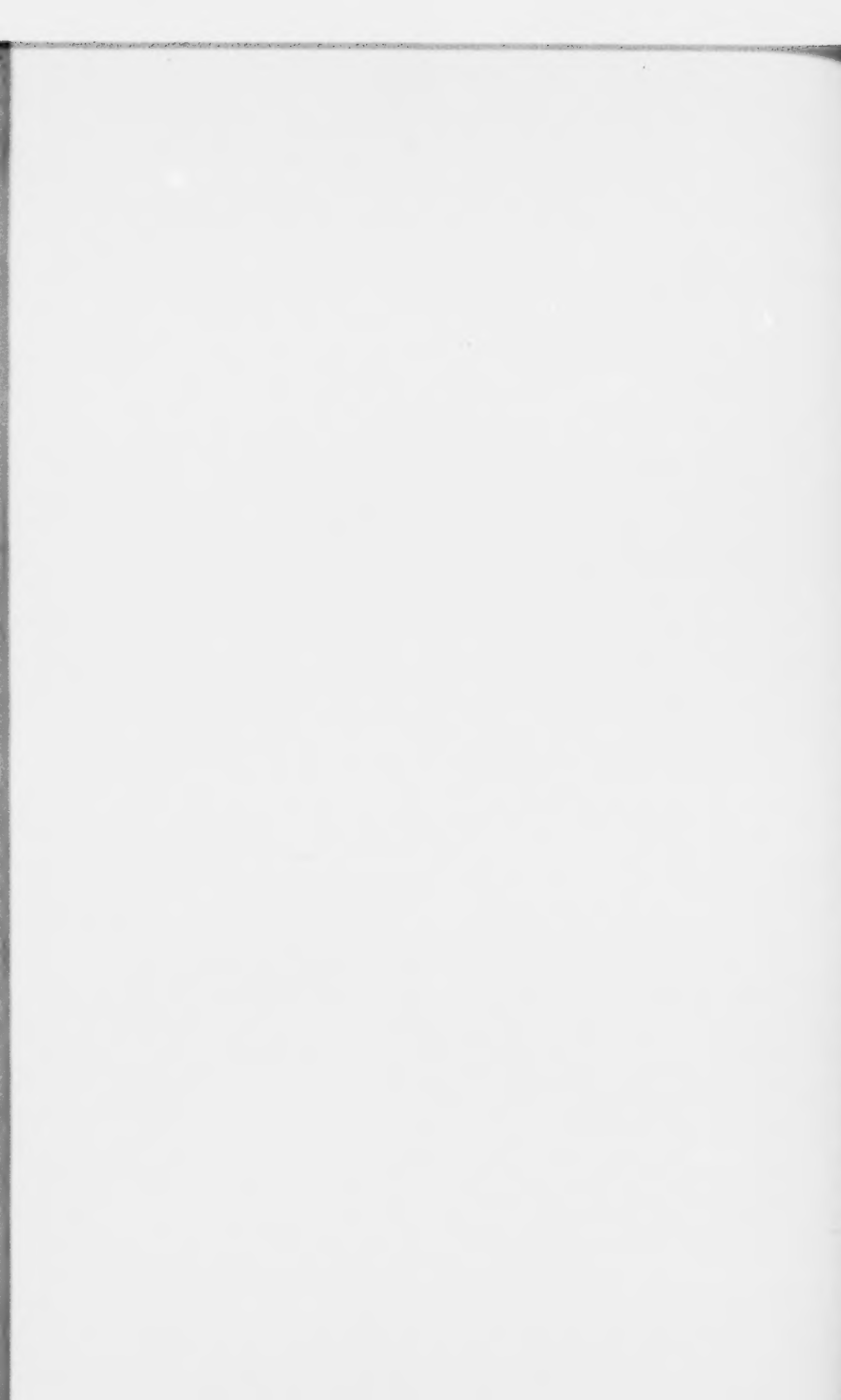
WHEREFORE, your respondent respectfully requests that the writ of certiorari prayed for by petitioner to be directed to the United States Circuit Court of Appeals for the Second Circuit, be denied by this Honorable Court.

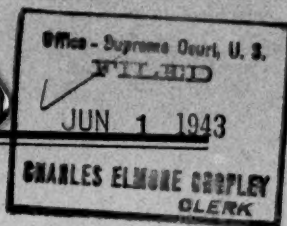
Most respectfully submitted,

NATHAN SCHWARTZ,
Respondent,
Pro se,
100 West 55th Street,
New York, N. Y.

April 27, 1943.







IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942

HARVEY S. COVER,

Petitioner,

vs.

NATHAN SCHWARTZ, doing busi-
ness as Hygeia Respirator Co.,
Respondent.

No. 906

PETITION FOR REHEARING

Of Petition for Writ of Certiorari to the United States
Circuit Court of Appeals for the Second Circuit.

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Counsel for Petitioner.

160 North La Salle Street,
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IN THE

Supreme Court of the United States

OCTOBER TERM, A. D. 1942

HARVEY S. COVER,

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ness as Hygeia Respirator Co.,
Respondent.

No. 906

PETITION FOR REHEARING

Of Petition for Writ of Certiorari to the United States
Circuit Court of Appeals for the Second Circuit.

*To the Honorable the Chief Justice of the United States,
and Associate Justices of the Supreme Court of the
United States:*

Petitioner, Harvey S. Cover, presents this, his Petition
for a Rehearing in the above entitled cause, and in support
thereof respectfully shows:

Preamble

We have endeavored in the original Petition for Writ of Certiorari herein, to point out to this Honorable Court that there is a distinct and definite conflict of the interpretation of the law as laid down by this Court in *Cuno v. Automatic Service Corp.*, 314 U. S. 84, 91, between the decisions of the United States Circuit Court of Appeals of the Second Circuit, on the one hand, as laid down by that court in its decision in *Ruby Pickard v. United Aircraft Corp.*, 128 F. (2d), 632, in which it interpreted and applied the rule requiring a "flash of genius" to constitute invention; and the decisions and interpretation placed upon the decision of this Court in the *Cuno* case, by the United States Circuit Court of Appeals of the Seventh Circuit, as fully set forth by that court in the case of *Chicago Foundry Co. v. Burnside Foundry Co.*, 56 U. S. P. Q. 283, and the United States Circuit Court of Appeals of the Sixth Circuit in the case of *United States Gypsum Co. v. Consolidated Expanded Metal Co.*, 130 F. (2d) 888, 892. (Petition, p. 17.)

The United States Circuit Court of Appeals of the Second Circuit in the case at bar by questions and remarks by the Judges sitting at the oral argument, made it perfectly clear that they were following the rule laid down by that Court in the *Picard* case. Unfortunately, the questions asked and remarks made during an oral argument do not appear in the record. But, the opinion itself shows that the court relied solely upon the "flash of genius" *Cuno* decision of this Court, in reaching its decision in the case at bar.

We have also pointed out that in the present case the defendant expressly waived the issue of invention (Pet. pp. 2, 3, 4), and that the trial court overrode the defend-

ant's waiver of this issue and insisted upon holding that the patent was invalid (Pet. pp. 2, 3, 4).

The Second Circuit Court of Appeals also refused to recognize the waiver of the issue of invention and affirmed the District Court, and in this, we submit, the Circuit Court of Appeals also erred. This is in conflict with the decisions of this court.

Reasons for Urging a Rehearing.

We endeavored in our original Petition and Brief to make clear the great public importance of the clarification of the decision of this Court in the *Cuno* case, in definitely stating what this Court meant when it used the words "flash of genius"; in other words, we endeavored to make clear the need for this Court clarifying what is required to constitute invention.

So far as we have been able to ascertain, only three of the ten United States Circuit Courts of Appeals have announced their respective interpretations of what this Court meant by the "flash of genius" decision in the *Cuno* case; the United States Circuit Court of Appeals of the Second Circuit holding that there can be no invention in anything that is the mere product of "persistent and intelligent search for improvement." The Seventh and Sixth Circuits having expressed opposite opinions.

As we understand the decisions of the Second Circuit, the use of experimentation through trial and error of Armstrong and Marconi, that produced the radio, would not constitute invention. Other great inventions could be enumerated without number, that were produced by the same method, such as the incandescent light, sulfanilimide, insulin, etc.

If the United States Circuit Court of Appeals of the Second Circuit has correctly interpreted the "flash of genius" decision, it is of great public importance to the general public; to the owners of more than eight hundred thousand unexpired patents outstanding in the United States; to approximately ten thousand patent lawyers, that they may have a guide in advising their clients; to tens of thousands of general practicing lawyers; and to every manufacturer in the United States, whether manufacturing under presumed protection of patents, or not, and to the tens of thousands of prospective inventors and investors in patent rights, that this Court should state what it meant when it used the words "flash of genius."

We most respectfully submit, therefore, that this Court should definitely lay down a rule as a guide in determining what is required to produce a patentable invention under the "flash of genius" decision in the *Cuno* case.

On the other hand, if the United States Circuit Courts of Appeals of the Seventh and Sixth Circuits have correctly interpreted the decision of this Court in the commonly called "Flash of genius *Cuno* case," then, it is just as vital and of even greater public importance, to all of these classes enumerated above, as well as the general public, and the tens of thousands of prospective inventors and investors, that this Court should decide and clarify the question as a guide for their future conduct.

If the United States Circuit Court of Appeals of the Second Circuit has correctly interpreted the decision of this Court in the "flash of genius *Cuno* case," then, it is of great public importance that that fact be known, as it will mean that there will be very few, if any, inventors

who will even attempt to procure a patent, and very few, if any, who own patents who will attempt to litigate them when copied by competitors.

If the interpretation of the "flash of genius" *Cuno* decision of this Court as interpreted by the United States Circuit Courts of Appeals of the Seventh and Sixth Circuits is correct, then, it is of vital and imperative public importance, that this Court should decide that question at the earliest possible date, to prevent any further great and irreparable loss and damage resulting, and continuing to result from the misconstruction of the *Cuno* decision by the Circuit Court of Appeals of the Second Circuit.

It is of further great importance that this Court decide the conflict between the decisions of the United States Circuit Court of Appeals of the Second Circuit on the one hand; and the United States Circuit Courts of Appeals of the Seventh and Sixth Circuits, on the other hand, as a guide to all United States District Courts, to other United States Circuit Courts of Appeals, and to the United States Circuit Court of Appeals of the District of Columbia, to prevent further conflicting decisions.

Patent litigation is expensive, and many great inventions have been made by poor men, who are unable to bear the expense of litigation, and the conflict of decisions between the United States Circuit Courts of Appeals makes it impossible for them to obtain any assistance in carrying on their litigation, to protect their patents, no matter how valuable their patents may be, or how flagrant the infringement may be.

We most respectfully urge that this Court reconsider

our original Petition for Writ of Certiorari and Brief, and vacate the order denying a writ of certiorari to the United States Circuit Court of Appeals of the Second Circuit, and grant the Petition as prayed for, and also avail itself of the opportunity to make clear what it meant when it used the term "flash of genius" in the *Cuno* case.

Wherefore, petitioner prays that his Petition for Writ of Certiorari be reconsidered and granted.

Most respectfully submitted,

HARVEY S. COVER,

By JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE,

Attorneys for Petitioner.

May 28th, 1943.

We hereby certify that the foregoing Petition for Re-hearing is filed in good faith and not for the purpose of delay.

JOSHUA R. H. POTTS,

EUGENE VINCENT CLARKE.

